



NATIONAL AERONAUTICS AND SPACE ADMINISTRATION

14 CFR Part 1245

RIN 2700-AD63

NOTICE: (12 -022)

Claims for Patent and Copyright Infringement

AGENCY: National Aeronautics and Space Administration.

ACTION: Final rule.

SUMMARY: The following are National Aeronautics and Space Administration (NASA) regulations relating to requirements for the filing of claims against NASA where a potential claimant believes NASA is infringing privately owned rights in patented inventions or copyrighted works. The requirements for filing an administrative claim are important since the filing of a claim carries with it certain rights relating to the applicable statute of limitations for filing suit against the Government. The regulations set forth guidelines as to what NASA considers necessary to file a claim for patent or copyright infringement, and they also provide for written notification to the claimant upon completion of an investigation by NASA.

DATES: This rule is effective on [INSERT DATE OF PUBLICATION IN THE FEDERAL REGISTER].

FOR FURTHER INFORMATION CONTACT: Ms. Helen M. Galus, National Aeronautics and Space Administration, Office of the General Counsel, Washington, DC 20546-0001. Telephone 202-358-3437.

SUPPLEMENTARY INFORMATION: On July 26, 2011, the Administrator published a notice of proposed rulemaking (NPRM) for patent and copyright infringement claims in the Federal Register (76 FR 44504). No public comments were received. Accordingly, NASA is issuing this rule with minor edits and only one change to reduce burden on respondents, namely, §1245.202 (b)(6), was amended to delete the request for a brief summary of any defenses or counterclaims made and positions maintained by opposing parties regarding noninfringement of patent(s), in prior initiated litigation.

The National Aeronautics and Space Act (51 U.S.C. 20113) authorizes the Administrator of NASA to settle administrative claims of patent and copyright infringement by NASA. In addition to that authority to acquire license rights and interests in patents and copyrights through settlement of claims, the Administrator has authority to settle claims of patent and copyright infringement pursuant to 22 U.S.C. 2356, 35 U.S.C. 183 and 286, and 28 U.S.C. 1498(b).

In accordance with these authorities, NASA is issuing regulations setting forth requirements for the filing of claims against NASA where a potential claimant believes NASA is infringing privately owned rights in patented inventions or copyrighted works. The regulations are designed to inform potential claimants as to what information must be supplied in their communication to NASA regarding alleged infringement before NASA will consider a claim to have been filed. The regulations identify certain commonly received communications which are concerned with rights in patents and

copyrights, but which will not be considered sufficient to constitute the formal filing of a claim.

The requirements for filing an administrative claim are important since the filing of a claim carries with it certain rights relating to the applicable statute of limitations for filing suit against the Government. In the case of patent infringement claims, Title 35 U.S.C. § 286 provides that the six-year statute of limitations for filing suits for patent infringement may, in the case of claims against the Government, be tolled up to six years between the date of receipt of a written claim for compensation by the Government and the date of mailing by the Government of a notice that the claim has been denied. Copyright infringement claims can be tolled indefinitely under 28 U.S.C.

§ 1498(b) between the date of receipt of a written claim for compensation by the Government and the date of mailing by the Government of a notice that the claim has been denied. The regulations set forth guidelines as to what NASA considers necessary to file a claim for patent or copyright infringement.

Section 1245.202(a) provides that in order for a potential claimant's communication to NASA to formally instigate a claim, it must specifically allege infringement by NASA, request compensation, identify a patent or copyright alleged to be infringed, and indicate an act or item which the potential claimant believes infringes the claimant's patent or copyright. Section 1245.203(a) advises the potential claimant where to forward communications regarding the alleged infringement. Section 1245.202(b) of the regulation identifies information which, although not necessary in order for a communication to be considered sufficient to constitute the filing of a claim, is

usually necessary to process a claim and, therefore, if presented initially with the claim, may serve to expedite the handling of the claim. The regulations provide for written notification to the claimant upon completion of an investigation by NASA.

The revisions to this rule are part of NASA's retrospective plan under EO 13563 completed in August 2011. NASA's full plan can be accessed at:

http://www.nasa.gov/pdf/581545main_Final%20Plan%20for%20Retrospective%20Analysis%20of%20Existing%20Regulations.pdf.

Regulatory Analysis Section:

Paperwork Reduction Act Statement

This rule does not contain an information collection requirement subject to the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 et seq.).

Executive Order 12866 and Executive Order 13563

Executive Orders 13563 and 12866 direct agencies to assess all costs and benefits of available regulatory alternatives and, if regulation is necessary, to select regulatory approaches that maximize net benefits (including potential economic, environmental, public health and safety effects, distributive impacts, and equity). Executive Order 13563 emphasizes the importance of quantifying both costs and benefits, of reducing costs, of harmonizing rules, and of promoting flexibility. This rule has been designated a "significant regulatory action" although not economically significant, under section 3(f) of Executive Order 12866. Accordingly, the rule has been reviewed by the Office of Management and Budget.

Regulatory Flexibility Act

It has been certified that this rule is not subject to the Regulatory Flexibility Act (5 U.S.C. 601) because it would not, if promulgated, have a significant economic impact on a substantial number of small entities. The rule sets forth policies and procedures for the filing and disposition of claims of infringement of privately owned rights in patented inventions or copyrighted works asserted against NASA. These policies and procedures would not have a significant economic impact on a substantial number of small entities as NASA typically has less than 10 of such claims asserted against it annually.

List of Subjects in 14 CFR Part 1245:

Claims, Inventions, Patent and copyright infringement.

For the reasons stated in the preamble, NASA amends 14 CFR Part 1245, by adding Subpart 2 to read as follows:

PART 1245—PATENTS AND OTHER INTELLECTUAL PROPERTY RIGHTS

Subpart 2—Claims for Patent and Copyright Infringement

Sec.

1245.200 Purpose.

1245.201 Objectives.

1245.202 Contents of communication initiating claim.

1245.203 Incomplete notice of infringement.

1245.204 Indirect notice of infringement.

1245.205 Processing of administrative claims.

Subpart 2—Claims for Patent and Copyright Infringement

Authority: 51 U.S.C. 20112-20113; 22 U.S.C. 2356; 35 U.S.C. 181-188 and 286; and 28 U.S.C. 1498.

§1245.200 Purpose.

The purpose of this subpart is to set forth policies and procedures for the filing and disposition of claims of infringement of privately owned rights in patented inventions or copyrighted works asserted against NASA.

§1245.201 Objectives.

Whenever a claim of infringement of privately owned rights in patented inventions or copyrighted works is asserted against NASA, all necessary steps shall be taken to investigate and to administratively settle, deny, or otherwise dispose of such claim prior to suit against the United States. The General Counsel, or designee, is authorized to investigate, settle, deny, or otherwise dispose of all claims of patent and copyright infringement, pursuant to the above-cited statutory authority.

§1245.202 Contents of communication initiating claim.

(a) Requirements for claim. A patent or copyright infringement claim for compensation, asserted against the United States as represented by NASA under any of the applicable statutes cited above, must be actually communicated to and received by an organization, office, or within a NASA Center. Claims must be in writing and must include the following:

(1) An allegation of infringement.

(2) A request for compensation, either expressed or implied.

(3) A citation to the patent(s) or copyright(s) alleged to be infringed.

(4) In the case of a patent infringement claim, a sufficient designation to permit identification of the accused subject matter (e.g. article(s) or process(es)) alleged to infringe the patent(s), giving the commercial designation, if known to the claimant, or, in the case of a copyright infringement claim, the accused subject matter (e.g. act(s) or work(s)) alleged to infringe the copyright.

(5) In the case of a patent infringement claim, a designation of at least one claim of each patent alleged to be infringed or, in the case of a copyright infringement claim, a copy of each work alleged to be infringed.

(6) As an alternative to paragraphs (a) (4) and (5) of this section, certification that the claimant has made a bona fide attempt to determine the accused subject matter, which is alleged to infringe the patent(s), or the accused subject matter alleged to infringe the copyright(s), but was unable to do so, giving reasons and stating a reasonable basis for the claimant's belief that the patent(s) or copyright(s) is being infringed.

(b) Additional information for patent infringement claims. In addition to the information listed in paragraph (a) of this section, the following material and information generally are necessary in the course of processing a claim of patent infringement. Claimants are encouraged to furnish this information at the time of filing a claim to permit rapid processing and resolution of the claim.

(1) A copy of the asserted patent(s) and identification of all claims of the patent(s) alleged to be infringed.

(2) Identification of all procurements known to the claimants that involve the accused item(s) or process(es), including the identity of the vendor(s) or contractor(s) and the Government acquisition activity or activities.

(3) A detailed identification and description of the accused article(s) or process(es) used or acquired by the Government, particularly where the article(s) or process(es) relate to a component(s) or subcomponent(s) of an item acquired, and an element-by-element comparison of representative claim(s) with the accused article(s) or process(es). If available, the identification and description should include documentation and drawings to illustrate the accused article(s) or process(es) in sufficient detail to enable determining whether the claim(s) of the asserted patent(s) read on the accused article(s) or process(es).

(4) Names and addresses of all past and present licensees under the patent(s) and copies of all license agreements and releases involving the patent(s). In addition, an identification of all assignees of the patent(s).

(5) A list of all persons to whom notices of infringement have been sent, including all departments and agencies of the Government, and a statement of the status or ultimate disposition of each.

(6) A brief description of all litigation involving the patent(s) which was initiated at any time prior to the claim being filed and their present status. This includes any defenses or counterclaims made and positions maintained by opposing parties regarding invalidity of the patent(s).

(7) A description of Government employment or military service, if any, by the inventor(s) or patent owner(s) including a statement from the inventor(s) or patent owner(s) certifying whether the invention claimed in the patents was conceived or reduced to practice, in part or in whole, during Government employment and whether such inventor(s) or owner(s) occupied any position from which such inventor(s) or owner(s) was capable of ordering, influencing, or inducing use of the invention by the Government.

(8) A list of all contract(s) between the Government and inventor(s), patent owner(s), or anyone in privity with the patent owner(s), under which work relating to the patented subject matter was performed.

(9) Evidence of title to the asserted patent(s) or other right to make the claim.

(10) A copy of the United States Patent and Trademark Office (USPTO) file history of each patent, if it is available to the claimant. Indicate whether the patent has been the subject of any interference proceedings, certification of correction request, reexamination, or reissue proceedings at the USPTO, or lapsed for failure to pay any maintenance fee. In addition, the status of all corresponding foreign patents and patent applications and full copies of the same.

(11) Pertinent prior art known to the claimant not contained in the USPTO file, for example, publications and foreign prior art.

In addition to the foregoing, if claimant can provide a statement that the investigation may be limited to the specifically identified accused article(s) or process(es) or to a specific acquisition (e.g. identified contract(s)), it may speed disposition of the claim.

Claimants are also encouraged to provide information on any ancillary matters that may have a bearing on validity or infringement.

(c) Denial for refusal to provide information. In the course of investigating a claim, it may become necessary for NASA to request information in the control and custody of the claimant that is relevant to the disposition of the claim. Failure of the claimant to respond to a request for such information shall be sufficient reason alone for denying a claim.

§1245.203 Incomplete notice of infringement.

(a) If a communication alleging patent infringement or copyright infringement is received that does not meet the requirements set forth in §1245.202(a), the sender shall be advised in writing by the Agency Counsel for Intellectual Property:

- (1) That the claim for infringement has not been satisfactorily presented; and
- (2) Of the elements necessary to establish a claim.

(b) A communication, in which no infringement is alleged in accordance with §1245.202(a), such as a mere proffer of a license, shall not be considered a claim for infringement.

§1245.204 Indirect notice of infringement.

A communication by a patent or copyright owner to addressees other than those specified in §1245.202(a), such as NASA contractors, including contractors operating Government-owned facilities, alleging that acts of infringement have occurred in the performance of a Government contract, grant, or other arrangement, shall not be

considered a claim within the meaning of §1245.202(a) until such communication meets the requirements specified therein.

§1245.205 Processing of administrative claims.

(a) Filing and forwarding of claims. All communications regarding claims should be addressed to: Agency Counsel for Intellectual Property, Office of the General Counsel, National Aeronautics and Space Administration, Washington, DC 20546-0001. If any communication relating to a claim or possible claim of patent or copyright infringement is received by an agency, organization, office, or field installation within NASA, it shall be forwarded to the Agency Counsel for Intellectual Property.

(b) Disposition and notification. The General Counsel, or designee, shall investigate and administratively settle, deny, or otherwise dispose of each claim. When a claim is denied, the Agency shall so notify the claimant or the claimant's authorized representative and provide the claimant with the reasons for denying the claim. Disclosure of information shall be subject to applicable statutes, regulations, and directives pertaining to security, access to official records, and the rights of others.

(c) Termination of claims. If, while an administrative claim for patent or copyright infringement is pending against NASA, the claimant brings suit for patent or copyright infringement against the United States in the Court of Federal Claims based on the same facts or transactions as the administrative claim, the administrative claim shall thereupon be automatically dismissed, with no further action being required of NASA.

Charles F. Bolden, Jr.
Administrator

[FR Doc. 2012-6047 Filed 03/12/2012 at 8:45 am; Publication Date: 03/13/2012]